

REMARKS

The Amendments

Applicants have amended the specification to perfect several literature citations in the specification. Applicants have also cancelled claims 1-66 without prejudice. Finally, applicants have added claims directed to compositions comprising the antibodies of claims 67-70, 72-73, 75-76, 78-79 and 81-88 and methods of using those compositions to treat inflammatory diseases (i.e., added claims 92-94). Support for these amendments can be found, *inter alia*, in originally filed claims 54-56 and 65-66 and in the specification on page 8, lines 32-38 and page 44, line 38 to page 44, line 4 as originally filed. Original claims 67-88 and added claims 89-94 are now pending. Applicants reserve the right to pursue cancelled and removed subject matter in future applications claiming benefit from this application. No new matter has been added.

The Restriction Requirement

The Examiner has stated that restriction to one of 35 inventions is required under 35 U.S.C. § 121. Applicants traverse in part and amend in part with respect to Groups XXIX, XXXI, XXXII, XXXIV and XXXV. Applicants provisionally elect Group XXXV for initial substantive examination.

As discussed above, applicants have amended the method claims of Groups XXIX, XXXI and XXXII and the composition claims of Group XXXIV to depend from the antibody claims of Group XXXV (i.e., added claims 92-94 and 89-91, respectively). Applicants request that the Examiner examine added claims 89-94 with the claims of Group XXXV.

The Manual of Patent Examining Procedure (MPEP) states that there are two criteria for a proper requirement of restriction between patentably distinct inventions. The first is that the inventions must be independent or distinct as claimed. The second is that there must be a serious burden on the Examiner if restriction is not required. The MPEP further states that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP § 803.

Serial No.: 09/724,341

Applicants do not believe that there is a serious burden on the Examiner to examine the compositions and methods of the added claims with antibodies of Group XXXV. If the Examiner will not examine added claims 89-94 with the claims antibodies of Group XXXV at this time and the claims of Group XXXV are subsequently found allowable, applicants request that the Examiner rejoin added claims 89-94 [MPEP § 821.04].

The Examiner has stated that applicants are required to make species elections for inventions recited in paragraphs 9-12 of the Office Action for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable. In view of the cancellation of claims 1-66 and the addition of claims 92-94 directed to inflammatory diseases, applicants believe that the species election requirements stated in paragraphs 9-11 of the Office Action are not appropriate. However, for completeness, applicants elect the following species for paragraphs 9-11 - - inflammatory bowel disease, ovarian cancer, rheumatoid arthritis and AIDS, respectively. If the Examiner believes that applicants must elect a particular type of inflammatory disease, then applicants elect an inflammatory bowel disease (IBD).

Claims 92-94 read upon an inflammatory bowel disease. This election is made expressly without waiver of applicants' rights to continue to prosecute and to obtain claims to the non-elected subject matter either in this application or in other applications claiming benefit herefrom.

Applicants request entry of the amendments and examination of pending claims 67-94.

Respectfully submitted,
GENENTECH, INC.

Date: March 17, 2003

By: 

Elinor K. Shin
Reg. No. 43,117
Telephone: (650) 225-3536



09157

PATENT TRADEMARK OFFICE
#126399